

Remarks

In the present Office Action, the Examiner rejected claims 1, 4, 6-11, 14, 15, 18-21, 29-33 and 35-41 under 35 U.S.C. 102(b) as being anticipated by Buske (US 3,524,782, hereinafter the '782 patent). The Examiner further rejected claims 2 and 5 under 35 U.S.C. 103(a) as being unpatentable over the '782 patent, while claims 3, 12, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '782 patent in view of Konkol et al (US 5,735,549). The Examiner rejected claim 17 under 35 U.S.C. 103(a) as being unpatentable over the '782 patent in view of Konkol et al and Franklin (US 5,255,456), while claims 23-28 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '782 patent in view of Horton-Steidle et al (US 6,167,679).

Independent Claim 1

Claim 1 has been cancelled and replaced by new claim 42, which more particularly recites the features of the present invention. Specifically, claim 42 recites that two labels are defined in a common form such that together the labels on the form make up a label set, shown in numerous figures, one example of which is depicted in original FIG. 6. One of the labels includes two printable regions on opposite sides of a stack of multiple plies; this label includes adhesive and release layer portions that cooperate with one another and a line of weakness that circumscribe the printable regions such that the label can be removed from the form and affixed to an object through exposed peripheral adhesive that remains with a second of the label's plies. The other label includes a printable region on the same outer surface of a first ply that is used for the first label, although in a different location on that surface. As with the first label, this second label includes adhesive and release layer portions that cooperate with one another such that the label can be removed and subsequently affixed to an object through exposed adhesive that remains with the first ply. In the first label, the adhesive forms a bond with the inner surface of the second ply, while in the second label, the adhesive forms a bond with the inner surface of the first ply. Thus, when the form is oriented on a planar surface (such as a table top) with the printable region of the second label and the first printable region of the first label face-up and the two labels removed and kept in the form's original

orientation, the exposed adhesive from the first label would be face-up, while the exposed adhesive from the second label would be face-down.

Support for the amended claims is clearly shown in FIG. 1 and described in the corresponding text at pages 9 through 11 of the original specification, where the nature of and cooperation between the various components making up the label set are depicted. The first label **181** is disposed on the right side of the form **100**, while the second label **182** is disposed on the left side of the form **100**. The nature of the two labels, as well as the different way each is affixed to an object, is a valuable feature of the claimed label set. For example, the first label may be useful as a pricing label or a packing list, while the second label may be useful as a shipping label, such as recited in dependent claims 8 and 9.

According to MPEP 2131, in order to be anticipatory, the reference must teach every aspect of the claimed invention. Thus, in addition to the other recited features, any purported reference must also include the amended language above. There is no indication that the '782 patent teaches a label set made up of different labels that are formed together on a common adhesive form. At most, the '782 patent teaches a continuous web of a single type of label (specifically, a coupon) repeated along the length of the web. Since amended claim 42 recites features neither present in nor suggested by the '782 patent, the Applicant submits that the claim is patentable over the reference.

Dependent Claims 8 and 9

The Examiner takes the position that it is the printed indicia that defines the nature of the labels, and that since printed indicia not functionally related to the substrate onto that which it is printed does not impart patentability, dependent claims 8 and 9 read on the device of the '782 patent. In support of that position, the Examiner cites *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983). The Examiner distorts the holding of *Gulack*, and ignores its facts. The court in *Gulack* did not broadly hold that printed matter claim limitations may be ignored in assessing the patentability of the claim. In fact, it held just the opposite. In fact, the invention of *Gulack* was held to be patentable over the prior art

precisely because the claims included limitations to printed matter that distinguished those claims from the prior art. *Gulack* dealt with a paper band formed as an endless loop upon which were printed a plurality of digits at regularly spaced intervals. The digits were integers that were generated by a specific algorithm. This band was capable of being used for "magic tricks" and also "to display various aspects of number theory." In *Gulack*, the Board had affirmed a rejection based on a prior art hat band that carried different indicia. The Board had given claim limitations about the printed digits no patentable weight. The Federal Circuit reversed the Board, holding that the claim limitations regarding the data could not be ignored in comparing the claim to the prior art. The Court held that the printed matter is to be considered to establish patentability if the printed matter is functionally related to the substrate on which it is printed. In the *Gulack* case, the Court found this functional relationship in that (1) the band supports the digits, and (2) there is an endless sequence of such digits with each digit in a unique position with respect to every other digit in the endless loop.

This is similar to the claimed invention in the present application. The shipping label supports the indicia specifying the shipping instructions, destination and related information, while the packing list supports the indicia specifying contents and related information. In both cases, the position of such information is unique to the shipping label and packing list such that each can be applied to a different location on an object (such as a box containing items to be shipped); such printed indicia and its unique position relative to shipping labels and packing lists contribute to the distinctness of the respective label and list structure, as there is a cooperation between the indicia and the structure. The Applicant goes to great lengths to highlight the structural differences between the two, where original specification page 11, lines 4 through 10 clearly state that shipping labels and packing lists have different requirements, and hence possess different attributes. Likewise, original FIG. 1 shows an exemplary form **100** containing both shipping label (shown as second label **182**) and packing list (shown as first label **181**), where the one-sided nature of printed indicia on the shipping label makes it of significantly simpler construction than the packing list with two-sided printing. Moreover, original FIGS. 5A through 5F highlight both the different structure and

different use of the two. Specifically, the nature of a packing list (or a pricing list, as well as other specific embodiments of the first label) is that the list of the contents is often desirably kept hidden to reduce the temptation of theft in the case of high-value items. As such, these features are deemed important in shipping labels and packing lists, and are in fact structural differences that the Examiner cannot ignore. For these reasons, the present rejection of claims 8 and 9 is not well taken, and should be withdrawn.

Independent Claim 29

Independent claim 29 has been cancelled and replaced by new claim 43 to more precisely recite the present invention. Claim 43 recites that a first label is different than a second label. The first label includes two opposed printable surfaces and has a peripheral adhesive layer. Thus, even upon removal of the first label from the form, a portion of the adhesive layer **130** remains with and surrounds the first label (thereby acting as a picture frame-like adhesive border); this remaining adhesive layer allows the label to be subsequently affixed to (first ply down) a box, container or related object. There is nothing in the '782 patent that includes the recited feature. While FIG. 10 does show an adhesive layer **23** surrounding a label **25** (or, in the alternative, label **28**), such adhesive does not form a part of the first label and does not remain in contact with the second ply **22**. In fact, what adhesive **23** that does remain with the second ply **22** is not capable of affixing the first label to an object, as such remaining adhesive **23** and second ply **22** have become scrap upon such removal, as clearly indicated at column 2, line 71 of the '782 patent. Thus, on the strength of this significant difference alone, the '782 patent does not anticipate new claim 43. In addition, the recitation of the second label clearly indicates that the form includes at least two different kinds of labels, something not in evidence in the coupons taught in the '782 patent.

Independent Claim 37

Claim 37 has only been amended to more precisely recite the nature of the line of weakness, as well as to remove the requirement that the line of weakness be the location on the form where the shipping label is removed from it. In other respects, the claim is in its original form.

The Examiner states at page 10 of the Office Action that the '782 patent teaches a combination packing list and shipping label form. The Applicant strenuously disagrees, as there is not even a scintilla of evidence that the '782 patent even remotely suggests such a device. Instead, the '782 patent teaches a protection label over a coupon, neither of which are recognized as being the equivalent of a shipping label or packing list. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Miller*, 169 USPQ 597, 600 ((CCPA 1971), quoting *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)). Since to hold that the device of the '782 patent includes the claimed shipping label and packing list would be to destroy the plain meaning of that claim requirement, the Applicant respectfully submits that claim 37 is not anticipated by the teaching of the '782 patent, and as such, the present rejection should be withdrawn.

In conclusion, the Applicant submits that new independent claims 42 and 43, as well as amended independent claim 37 are allowable over the cited art for the reasons stated above. Furthermore, since all of the dependent claims place additional limitations on the independent claims from which they depend, the Applicant submits that they too are allowable over the cited art. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response.

Respectfully submitted,

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